

Application No.: 10/030409

Case No.: 54928US002

REMARKS

In the Amendment filed by applicant on May 12, 2004, the phrase "using a static frictional weight of 200 g, and a 90° peel adhesion on a stainless steel surface" appearing after the phrase "to DIN 53.375-B on a stainless steel surface" was inadvertently omitted. The phrase "using a static frictional weight of 200 g, and a 90° peel adhesion on a stainless steel surface" is included in the above presented claim 1, as it appeared in when the application was filed.

Claims 1-2 and 12-21 are pending. Claims 1-2 and 12-21 stand rejected under 35 USC § 103(a) as being unpatentable over Hilding. (US patent 3,937,491). Claim 1 requires a note-pad comprising a plurality of sheets of paper and a base sheet each having a bottom face, the bottom face of said base sheet bearing an exposed skid-resistant layer that defines a uniform bottom surface of the note pad. To establish a *prima facie* case of obviousness, the prior art reference must teach or suggest all the claim limitations. MPEP § 2143.

Hilding does not teach or suggest the note-pad of claim 1 having a base sheet with a bottom face bearing an *exposed* skid-resistant layer that defines a *uniform bottom surface* of the note pad. As shown in FIG. 2 of Hilding, which is a bottom plan view of the pad, the deformable sheet member 16 is surrounded by pad support member 18 and spaced supports 20 are interspersed throughout sheet 16. The pad support member 18 and spaced supports 20 are not a skid-resistant layer because they are a "slippery material having a low coefficient of friction relative to that of the sheet 16." (Hilding, col. 2, ll. 1-2). "The support member 18 and the spaced supports 20 allow the pad to be slid across the surface of a desk or the like without the sheet 16 touching the surface upon which the pad is positioned." (Hilding, col. 2, ll. 12-15).

As disclosed, support member 18 and spaced supports 20 are not skid-resistant. Therefore, there is not an exposed skid-resistant layer that defines a *uniform bottom surface* of the note pad as required by claim 1.

There must be some suggestion or motivation to modify the reference to establish a *prima facie* case of obviousness. MPEP § 2143. Hilding does not include a suggestion or motivation to modify the exposed layer to include a skid-resistant layer that defines a uniform bottom surface. In the Summary, Hilding states that the "pad is provided which has on the bottom thereof

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supports which have a low coefficient of friction to allow the pad to be easily slid across a surface." Therefore, without the pad support member 18 and spaced supports 20, the pad in Hilding would not be capable of being easily slid across a surface, a necessary feature identified by Hilding.

Hilding does not teach or suggest the note-pad of claim 1 having a base sheet with a bottom face bearing an *exposed* skid-resistant layer that defines a *uniform bottom surface* of the note pad. Further, Hilding does not include a suggestion or motivation to modify the exposed layer to include a skid-resistant layer that defines a uniform bottom surface. Therefore, claim 1 is not made obvious by the teachings of Hilding.

Claims 1-2 and 12-21 stand rejected under 35 USC § 103(a) as being unpatentable over Holt (US patent 5,405,168). Claim 1 requires a note-pad comprising a plurality of sheets of paper and a base sheet each having a bottom face bearing an exposed skid-resistant layer having a 90° peel adhesion on a stainless steel surface of less than 0.1 N/1.27 cm as measured according to FINAT Test Method no. 2. To establish a *prima facie* case of obviousness, the prior art reference must teach or suggest all the claim limitations. MPEP § 2143.

Holt does not teach or suggest a skid-resistant layer with a 90° peel adhesion on a stainless steel surface of less than 0.1 N/1.27 cm as measured according to FINAT Test Method no. 2 as required by claim 1. Holt teaches that the base 30, which supports the sheets 12, "provides friction between a support surface and the base 30 such that the combination pad 10 stays in place while being used." (Holt, col. 3, ll. 45-47). However, Holt does not teach or suggest any particular peel adhesion properties of its combination computer mouse pad and note pad.

Further, it would not have been obvious to one of ordinary skill in the art to provide the claimed peel adhesion to Holt. To use the device in Holt as just a mouse pad, a user would be applying a certain level of lateral movement, to control the mouse, and not necessarily any vertical pressure. Using a mouse does not require vertical pressure from the user. Therefore, the base on the combination mouse pad and note pad must have a high enough peel adhesion to prevent lateral movement of the mouse pad and note pad while just a mouse is being used (no vertical pressure being applied).

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Claim 1 requires a specific peel adhesion. The specification of the present invention has identified that if the peel adhesion of the skid-resistant layer, as required by claim 1 of the present application, is higher than 0.1 N/1.27 cm, "the note-pad tends to adhere, in particular, to smooth surfaces such as, for example, polished desk surfaces, which makes it impossible to easily slide the note-pad over the desk surface when no note is taken." (page 11, ll. 16-20). The claimed peel adhesion of the present invention allows a user to easily slide the note-pad over a surface when no note is taken.

Holt, however, requires a certain level of adhesion to the supporting surface so that the mouse pad/note pad does not slide when a mouse is slid over the surface and no vertical pressure is applied. The level of adhesion desired by the present invention, when no pressure is applied to the note pad, would be different than the level of adhesion desired by Holt because a user must be able to slide a mouse on the surface (applying no vertical pressure) without sliding the mouse pad/note pad.

There must be a reasonable expectation of success to establish a *prima facie* case of obviousness. MPEP § 2143. The ways of using the device in Holt are different than the present invention because the Holt device remains stationary when simply a mouse is being used without vertical pressure being applied. In one example, the peel adhesion of the present invention would allow the note-pad to be easily moved when no note is taken, but that same peel adhesion on the Holt device would also allow easy lateral movement of the mouse pad/note pad when just the mouse is being used (without vertical pressure). In such a situation, the Holt device would be unsatisfactory for its intended purpose that "the combination pad 10 stays in place while being used."

A *prima facie* case of obviousness has not been established. Therefore, claim 1 is not made obvious by Holt.

Claims 2 and 12-21 each add additional features to claim 1. Claim 1 is patentable over Hilding and Holt for the reasons given above. Thus, dependent claims 2 and 12-21 are likewise patentable. In summary, the rejection of claims 1-2 and 12-21 under 35 USC § 103(a) as being unpatentable over Hilding and Holt has been overcome and should be withdrawn.

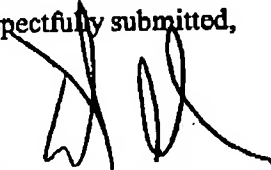
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In view of the above, it is submitted that the application is in condition for allowance.
Reconsideration of the application is requested.

Respectfully submitted,

11/2/2004
Date

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